

APR 10 2006

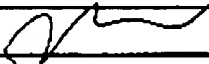
PTO/SB/21 (09-04)

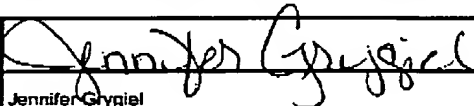
Approved for use through 07/31/2006, OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/898,422	
	Filing Date	July 2, 2001	
	First Named Inventor	Hiroaki Shinohara	
	An Unit	2616	
	Examiner Name	Shibru, Helen	
Total Number of Pages in This Submission	14	Attorney Docket Number	50R4615

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Credit Card Payment Form (PTO-2038)
Remarks: _____		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Rogitz & Associates	
Signature		
Printed name	John L. Rogitz	
Date	April 10, 2006	Reg. No. 33,549

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name	Jennifer Grygiel	Date April 10, 2006

This collection of information is required by 37 CFR 1.5. This information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**RECEIVED**  
**CENTRAL FAX CENTER**  
**APR 10 2006**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Applicant: Shinohara	)	Art Unit: 2616
	)	
Serial No.: 09/898,422	)	Examiner: Shibru
	)	
Filed: July 2, 2001	)	<b>50R4615</b>
	)	
For: <b>SYSTEM AND METHOD FOR LINKING DVD</b>	)	April 8, 2006
<b>TEXT TO RECOMMENDED VIEWING</b>	)	750 B STREET, Suite 3120
	)	San Diego, CA 92101
	)	

**APPEAL BRIEF**

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

**Table of Contents**

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Summary of Claimed Subject Matter .....	2
(6)	Grounds of Rejection to be Reviewed.....	3
(7)	Argument.....	3
App.A Appealed Claims		
App.B Evidence Appendix		
App.C Related Proceedings Appendix		

1168-41.APP

04/11/2006 MBINAS 00000013 09090422

02 FC:1402

500.00 0P

**CASE NO.: 50R4615**  
**Serial No.: 09/898,422**  
**April 8, 2006**  
**Page 2**

**PATENT**  
**Filed: July 2, 2001**

**(1) Real Party in Interest**

The real parties in interest are Sony Corp. and Sony Electronics Inc.

**(2) Related Appeals/Interferences**

No other appeals or interferences exist which relate to the present application or appeal.

**(3) Status of Claims**

Claims 1, 3, 5, 6, 12, 13, 15, and 17-19 are pending and finally rejected, which rejections are appealed, and claims 2, 4, 7-11, 14, 16, and 20-27 have been canceled.

**(4) Status of Amendments**

An amendment canceling claims 7-11 has been filed.

**(5) Summary of Claimed Subject Matter**

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 recites a system for returning recommendations related to a recorded program that includes a DVD player (22, figure 1; page 5, line 2) for playing a disk containing media-stored content including text. The system also includes a TV (12, figure 1, page 4, line 3) communicating with the DVD player, and a

1168-41.A/P

CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 3

PATENT  
Filed: July 2, 2001

personal video recorder (PVR) (31, figure 1, page 6, line 6) including a processor (28, figure 1, page 6, line 3) coupled to the TV and receiving the media-stored content. The processor accesses a database (30, figure 1, page 6, line 4) to return recommendations based at least partially on a viewer-selected portion of the text or to record at least one broadcast program based at least partially on a viewer-selected portion of the text (discussion on page 8).

Claim 12 sets forth a system for linking content to viewing and/or shopping recommendations that includes means (e.g., input device 26, figure 1, page 5, line 21) for selecting alpha numeric characters that are part of a DVD content, and means (e.g., the processor supra) for receiving the alpha numeric characters. Means (e.g., the processor supra) are responsive to the means for selecting for automatically accessing a source of recommended viewing and/or shopping.

**(6) Grounds of Rejection to be Reviewed on Appeal**

(a) Claims 1 and 3 have been rejected under 35 U.S.C. §103 as being unpatentable over Mankovitz, USPN 5,541,738 in view of official notice.

(b) Claims 5 and 6 have been rejected under 35 U.S.C. §103 as being unpatentable over Mankovitz in view of Killian, USPN 6,163,316 and official notice.

(c) Claims 12, 15, and 17-19 have been rejected under 35 U.S.C. §102 as being anticipated by Killian.

**(7) Argument**

116841.APP

CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 4

PATENT  
Filed: July 2, 2001

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, *id.*, page 49979.

Appellant gratefully acknowledges that the examiner and her primary have reviewed this case after final. Appellant understands that they have concluded that the application contains no patentable subject matter. Accordingly, it is expected that having already given the application extra review, no need will exist to reopen prosecution, and an Examiner's Answer will be filed and the case sent to the Board.

(a) Mankovitz uses a VCR to record a broadcast EPG so that a user can select from the EPG future programming for recording. In contrast, Claim 1 allows a user to select content from a DVD (which typically does not include EPG content), and the disk-borne content is then used by a PVR to return viewing recommendations and/or to schedule recording.

There are several difficulties with the rejection, the first being that is not clear what the examiner is relying on in Mankovitz for which claim elements. The only specific portions of Mankovitz that the rejection points to are figure 7 and col. 10, lines 40-51, but this simply shows and discusses the EPG that is recorded on the VCR. It is thus not apparent what the examiner is relying on as being the alleged "personal video recorder" mentioned in the first line of page of 3 the Office Action. In fact, Mankovitz does not appear to teach a PVR or a DVD.

116841.APP

CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 5

PATENT  
Filed: July 2, 2001

The second difficulty is that official notice has been taken of DVDs "for the purpose of playing and displaying media content retrieved from disk as specified in claim 1", proposing to replace component 40 (the VCR tape) of Mankovitz with a DVD. This difficulty is multi-faceted. First, if the VCR of Mankovitz is replaced with a DVD, then what in Mankovitz is left to establish the claimed PVR? Second, Claim 1 does not simply specify playing content from a DVD as alleged in the taking of official notice; it specifies allowing a user to select text from the DVD and then returning a viewing recommendation or scheduling a recording based on the selection. Third, because Mankovitz envisions using a broadcast EPG, replacing a broadcast recorder like a VCR with a read-only DVD would not work in Mankovitz, thus establishing an improper modification to Mankovitz, see MPEP §2143.01 (citing In re Gordon). Accordingly, setting aside for the moment the issue of the legitimacy of the taking of official notice, three reasons exist why the officially noticed fact still would not result in Claim 1.

Turning to the issue of the legitimacy of the taking of official notice, MPEP §2144.03 advises that the taking of official notice can be taken only of facts that "are capable of instant and unquestionable demonstration as to defy dispute", giving, as an example, adjusting flame intensity as needed for heat. According to the MPEP, official notice "is permissible only in some circumstances", and *should be "rare" in final rejections*. In any case, according to the MPEP official notice is most inappropriate of technical facts in areas of esoteric technology or of specific knowledge of the prior art. Still further, "ordinarily there must be some form of evidence in the record to support an assertion of common knowledge", and "general conclusions concerning what is basic knowledge without specific factual findings will not support an obviousness rejection."

1166-41LAPP

CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 6

PATENT  
Filed: July 2, 2001

It must be noted in addition that the question is not just whether various elements are well known, but also where the prior art supplies the motivation to combine the allegedly well-known features with the rest of the claimed elements. That is, regardless of how an element is identified in the prior art, i.e., using a reference or "official notice", the remaining task for an examiner is to show why the prior art suggests the element in the combination claimed.

Plainly the standards in the MPEP for taking official notice have not been met in the final rejections. Appellant is not claiming a DVD in a vacuum. Appellant is claiming it for a new purpose - allowing a user to make a selection from DVD content that can be used to return viewing recommendations or to schedule recording. These uses of DVDs are hardly the types of facts that "are capable of instant and unquestionable demonstration as to defy dispute."

Not only is this new use of the DVD a poor candidate for dismissing by the expedience of "official notice", but regardless of where a teaching of a DVD originates there is no fair prior art suggestion to substitute a DVD for Mankovitz' VCR because it would then seem that recording the broadcast EPG as required by Mankovitz would be rendered problematic. Without evidence that at the time the present invention was made it was known that DVDs receive and record broadcast EPGs, the examiner has not complied with MPEP §2142 (to establish a *prima facie* case of obviousness, an examiner must identify a suggestion to modify the cited reference(s) as proposed by the Examiner to arrive at the instant claimed invention, and set forth why the Examiner believes that a reasonable expectation of success exists for the proposed modification of the references which would be necessary to arrive at the claimed subject matter.)

116841.APP

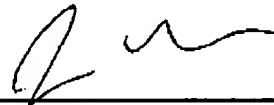
CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 7

PATENT  
Filed: July 2, 2001

(b) In addition to the reasons above, dependent Claims 5 and 6 are further patentable because the examiner has interpreted the claimed "database" to be the broadcast station itself (page 4, last three lines of Office Action), whereas it does not appear from the relied-upon figure 1 of Killian that broadcast content is received from anything other than a conventional broadcast source, as opposed to the Internet. Accordingly, combining Killian with Mankovitz and official notice as the references have been interpreted in the Office Action fails to reach Claims 5 and 6, wherein the "database" is received from a WAN.

(c) In Killian, an EPG applet 70 with viewer profile 80 is downloaded from the Internet and run on the JAVA platform 12, col. 8, lines 5-8 and figures 1 and 3. It is not borne on a DVD much less is it alphanumeric content on a DVD as recited in Claim 12. In short, nothing in Killian remotely suggests recording or recommending content based on a user selecting text from a DVD or other player.

Respectfully submitted,



---

John L. Rogitz  
Registration No. 33,549  
Attorney of Record  
750 B Street, Suite 3120  
San Diego, CA 92101  
Telephone: (619) 338-8075

JLR:jg

1168-41.APP



CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 8

PATENT  
Filed: July 2, 2001

#### APPENDIX A - APPEALED CLAIMS

1. A system for returning recommendations related to a recorded program, comprising:  
a DVD player for playing a disk containing media-stored content including text;  
a TV communicating with the DVD player; and  
a personal video recorder (PVR) including a processor coupled to the TV and receiving the media-stored content, the processor accessing at least one database to return recommendations based at least partially on a viewer-selected portion of the text or to record at least one broadcast program based at least partially on a viewer-selected portion of the text.
3. The system of Claim 1, further comprising an input device manipulable to establish the selected portion.
5. The system of Claim 1, wherein the database is updatable with information available on a wide area computer network (WAN).
6. The system of Claim 5, wherein the processor accesses the WAN to update the database.
12. A system for linking content to viewing and/or shopping recommendations, comprising:  
means for selecting alpha numeric characters that are part of a DVD content;  
means for receiving the alpha numeric characters; and  
means responsive to the means for selecting for automatically accessing a source of recommended viewing and/or shopping.
13. The system of Claim 12, further comprising means for storing at least some of the content.
15. The system of Claim 12, wherein the means for selecting is a user input device.

1108-41.APP

CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 9

PATENT  
Filed: July 2, 2001

17. The system of Claim 12, wherein the means for receiving includes a personal video recorder (PVR).
18. The system of Claim 12, wherein the source of recommended viewing and/or shopping communicates with a WAN.
19. The system of Claim 12, further comprising media player means for playing media-stored content on a storage medium and sending the media-stored content to a television.

1168-41.APP

CASE NO.: 50R4615  
Serial No.: 09/898,422  
April 8, 2006  
Page 10

PATENT  
Filed: July 2, 2001

**APPENDIX B - EVIDENCE**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

116E-4LAPP

**CASE NO.: 50R4615**  
**Serial No.: 09/898,422**  
**April 8, 2006**  
**Page 11**

**PATENT**  
**Filed: July 2, 2001**

**APPENDIX C - RELATED PROCEEDINGS**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1108-41.APP